

REMARKS

In the September 15, 2009, Office Action, the Examiner:

- a. Rejected 15, 17 & 19 under 35 U.S.C. §101 as claiming the same invention as that of claims 7 and 9 of USP 6,726,549;
- b. Rejected 15, 17 & 19 under 35 U.S.C. §101 as claiming the same invention as that of claims 7 and 9 of USP 6,524,172;
- c. Rejected 18 and 21-23 on the ground of nonstatutory double patenting as being unpatentable over claims 1-13 of USP 6,524,172 and claims 1-9 of USP 6,726,549 in view of Abbot USP 5,618,177; and
- d. Objected to claims 25, 26 and 28 as being dependent on a rejected base claim, but allowable if rewritten into independent form.
- e. Indicated that the terminal disclaimer does not comply with 37 CFR 1.32(c)(3) because more than ten practitioners are listed.

Applicants respectfully request reconsideration and withdrawal of the rejections of 15, 17 and 19 inasmuch as these claims do not claim the same invention as claimed in the '549 and '172 patents.

Applicants have obviated the obviousness type double patenting rejection of claims 18 and 21-23 by the terminal disclaimer.

Applicants submit that claims 15, 17 and 19 of the present application do not claim the same invention as that of claims 7 and 9 of the '549 patent or as that of claims 5 and 7 of the '172 patent. As stated in MPEP §804:

“A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).”

Thus, one way to test whether there is same invention type double patenting as asserted by the Examiner is to examine whether any of claims 15, 17 and 19 could be

literally infringed without literally infringing any of the referenced claims of the '549 and the '172 patent.

Claims 15, 17 and 19 of the present application read:

15. A particle blast apparatus, comprising:
- (a) a hopper for receiving particles for introduction into a flow of transport gas; and
 - (b) an impulse assembly configured to impart energy to said hopper, said impulse assembly carried by said hopper.

17. The particle blast apparatus of claim 15, comprising a frame, said frame supporting said hopper, said hopper not being rigidly supported by said frame.

19. The particle blast apparatus of claim 15, wherein said particles are cryogenic particles and said apparatus is configured to introduce said particles into the flow of transport gas.

Claim 7 of the '549 patent depends from claim 6, which depends from claim 1. These claims read:

1. A particle blast apparatus, comprising:
- (a) at least one hopper support carried by said particle blast apparatus and
 - (b) a hopper for receiving particles, said hopper being carried by and mechanically isolated from said at least one hopper support.

6. The particle blast apparatus of claim 1, comprising an impulse assembly configured to deliver energy to said hopper.

7. The particle blast apparatus of claim 6, wherein said impulse assembly is carried by said hopper.

9. The particle blast apparatus of any of claims 1-8 wherein said particles are cryogenic particles.

Claim 5 of the '172 patent depends from claim 6, which depends from claim 1. These claims read:

- 4. A particle blast apparatus, comprising:
 - (a) at least one hopper support;
 - (b) a hopper for receiving particles, said hopper being carried by and mechanically isolated from said at least one hopper support; and
 - (c) an impulse assembly configured to deliver energy to said hopper.

5. The particle blast apparatus of claim 4, wherein said impulse assembly is carried by said hopper.

7. The particle blast apparatus as in any of claims 1-6 wherein said particles are cryogenic particles.

Applying the test identified in MPEP §804, in order for any of claims 15, 17 or 19 to be literally infringed, at least claim 15 must be literally infringed. Thus, the focus begins with comparing claim 15 to the cited claims of the '549 and the '172 patents. Essentially is there a configuration which would infringe claim 15 but not infringe any of the cited claims of the '549 or the '172 patents.

In order to infringe any of the cited claims of the '549 patent, at least claim 1 must be infringed. Claim 1 requires, inter alia, that the hopper be mechanically isolated from the at least one hopper support. However, claim 15 of the present application contains no such limitation. A particle blast apparatus that meets the limitations in subparagraphs (a) and (b) of claim 15 but does not have a mechanically isolated hopper infringes claim 15 but not claim 1. Thus, none of claims 15, 17 or 19 claim the same invention as claims 7 or 9 of the '549 patent.

In order to infringe any of the cited claims of the '172 patent, at least claim 4 must be infringed. Claim 4 requires, inter alia, that the hopper be mechanically

isolated from the at least one hopper support. As mentioned above, claim 15 of the present application contains no such limitation. A particle blast apparatus that meets the limitations in subparagraphs (a) and (b) of claim 15 but does not have a mechanically isolated hopper infringes claim 15 but not claim 4. Thus, none of claims 15, 17 or 19 claim the same invention as claims 5 or 7 of the '172 patent. (Applicants note that claim 7 is a multiple dependent claim, and also depends from claims 1 and 2 of the '172 patent. Although the Examiner did not cite either of these claims, Applicants note that both claims 1 and 2 require either a mechanical isolator or that the hopper be mechanically isolated.)

Terminal Disclaimers

The Office Action indicates that the terminal disclaimer does not comply with 37 CFR 1.32(c)(3) because more than ten practitioners are listed. However, the Office Action discusses the rule in regard to the power of attorney. The undersigned thanks the Examiner for directing him to USPTO Paralegal Janice Ford at (571)272-0526.

During a discussion with Ms. Ford, she indicated that the issue was with the power of attorney, because, although executed in 2002, it had been filed in July, 2004, which is the rules changed in June 2004 to limit the number of attorneys listed in a power of attorney to no more than ten. Ms. Ford confirmed that the rule in effect at the time the power of attorney was filed is controlling. Thus, if the power of attorney currently on file was filed prior to the rule change in 2004, then the ten practitioner limit did not apply to it.

That is the case: The power of attorney currently on file was filed with the application on March 29, 2004, prior to the rule change in June 2004. The transmittal letter submitted with the application, dated March 29, 2004, indicates "Copy of Declaration/Power of Attorney". The fact that the power of attorney currently on file was submitted prior to June, 2004, is evidenced by June 8, 2004, Notice To File Missing Parts, which indicates the only thing missing from the application was payment of the filing fee.

Applicants note that Ms. Ford may be confused as a result of the 28 page faxed copy of the previously filed power of attorney on July 15, 2004, submitted in

support of a corrected filing receipt. Nonetheless, the power of attorney currently on file was filed on March 29, 2004, prior to the rule change in 2004 and therefore is in compliance.

Applicants submit that claim 15 is allowable as amended. All claims which depend therefrom are allowable. Applicants request that the claims be allowed. The Examiner is invited to contact the undersign by telephone or by email at eacheson@fbtlaw.com if there are any remaining issues.

Respectfully submitted,

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